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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/484,098	01/18/2000	Albert D. Baker	19-3	9279

7590 11/19/2002
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EXAMINER
TODD, GREGORY G

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 11/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/484,098

Applicant(s)

BAKER ET AL.

Examiner

Gregory G Todd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This is a first office action in response to application filed, with the above serial number, on 18 January 2000, in which claims 1-21 are presented for examination. Claims 1-21 are therefore pending in the application.

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

2. The disclosure is objected to because of the following informalities: On page 6, line 21, "C1PC2" is suggested to be replaced with --C1-PC2--.

Appropriate correction is required.

Claim Objections

3. Claim 1 is objected to because of the following informalities: The phrase "network, and to establish based at least in part on the remotely assigned address information " is suggested to be replaced with --network; and to establish, based at least in part on the remotely assigned address information,--. Appropriate correction is required.

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4. Claims 1, 11, and 21 are objected to because of the following informalities: The phrase "attached the local network" is suggested to be replaced with --attached to the local network--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2 and 12 recite the limitation "the at least one device" in line 2. There is insufficient antecedent basis for this limitation in the claims.
7. Claims 8 and 18 recite the limitation "the sets of address substitution information" in line 1. There is insufficient antecedent basis for this limitation in the claims.
8. Claim 21 recites the limitation "the local network" in line 7. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 21 recites the limitation "the one or more external network elements" in line 7. There is insufficient antecedent basis for this limitation in the claim.
10. Claims 9 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no description in the disclosure or claims pertaining to the "remotely-assigned address information in a header thereof" and renders the claims indefinite.
11. Claims 10 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. The "related services" the gateway is to perform is not clearly depicted as to how the gateway is to perform these services and which "related" services exactly.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

13. Claims 1-3, 5-13, and 15-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Krishnan (hereinafter "Krishnan", 6,157,950).

14. As per Claims 1 and 11, Krishnan discloses an apparatus and a method for use in interfacing a local network to one or more external network elements, wherein Krishnan discloses:

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a gateway coupled between the local network and the one or more external network elements, the gateway being operative to determine remotely-assigned address information for a given device attached to the local network (at least col. 3, lines 17-28; col. 5, lines 30-34);

establish, based at least in part on the remotely assigned address information, a substitution address for use by at least one other device attached to the local network when communicating with the given device (performing subnet masking operation on IP address to derive subnet address) (at least col. 7 line 59 - col. 8 line 9).

15. As per Claims 2 and 12.

the remotely-assigned address information comprises an Internet protocol (IP) address assigned to the at least one device by an external network element (at least col. 7, lines 59-64).

16. As per Claims 3 and 13.

the local network comprises a local area network (LAN) (at least col. 7, lines 59-64).

17. As per Claims 5 and 15.

the gateway stores remotely-assigned address information for each of a plurality of devices (computers 42 and 43) attached to the local network (at least col. 7, lines 22-30).

18. As per Claims 6 and 16.

the gateway stores a set of address substitution information for each of the plurality of devices, the set of address substitution information for a given one of the

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devices comprising an address to be used by the given device in communicating with the gateway (substituting IP address of gateway for computer 42 or 43) (at least col. 7, lines 31-42), and addresses to be used by the given device in communicating with each of the other devices (local IP addresses for each device connected to the LAN) (at least col. 9 line 61 - col. 10 line 26)

19. As per Claims 7 and 17.

the stored information comprises an address substitution matrix having a row of address information for each of the plurality of devices attached to the local network (internal LAN address database table) (at least col. 3, lines 28-33).

20. As per Claims 8 and 18.

a given one of the sets of address substitution information for a particular one of the plurality of devices comprises a set of IP addresses, each of which is sub-network compatible with an IP address remotely assigned to the corresponding device, such that communications between the given device and another one of the devices attached to the local network are not routed through an external network element (gateway with a subnet) (at least col. 7, lines 17-21; col. 5, lines 38-64).

21. As per Claims 9 and 19.

the gateway processes a particular received packet in order to replace remotely-assigned address information in a header thereof with a corresponding substitution address determined by the gateway (subnet addressing) (at least col. 5, lines 10-12, 38-64).

22. As per Claims 10 and 20.

the gateway intercepts at least one of control information and maintenance information received over the local network and associated with the given device so as to perform related services on behalf of the given device (at least col. 2, lines 39-46).

23. As per Claim 21, Krishnan discloses a machine-readable medium storing one or more programs, wherein Krishnan discloses:

determining, in a gateway coupled between the local network and the one or more external network elements, remotely-assigned address information for a given device attached to the local network (at least col. 3, lines 17-28; col. 5, lines 30-34);

establishing a substitution address for use by at least one other device attached the local network when communicating with the given device, based at least in part on the remotely-assigned address information (performing subnet masking operation on IP address to derive subnet address) (at least col. 7 line 59 - col. 8 line 9).

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan in view of Foley (hereinafter "Foley", 6,414,952).

26. Krishnan does not explicitly disclose the gateway comprising an ADSL termination unit-receive device (ADSL modem). However, the use and advantages for

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using such a modem is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Foley (at least Foley col. 16, lines 42-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of specifically an ADSL modem in Krishnan's gateway because this would expand the compatibility of the modems used in his gateway (at least col. 4, lines 17-25; col. 7, lines 48-52) with ADSL services.

Conclusion

27. Zisapel et al, Subramaniam et al, Howes et al, Millet et al, and Weiman are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory G Todd whose telephone number is (703)305-5343. The examiner can normally be reached on Monday - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703)308-7562. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-9153 for regular communications and (703)305-7201 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.



gt

November 14, 2002


ABIO ETIENNE
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